



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/100,671	06/19/1998	JEFFREY MARK ZUCKER	19010.715	8812
5073	7590	01/13/2006		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER RETTE, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/100,671	ZUCKER ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This office action is in response to amendment filed October 13, 2005. Applicant amended claims 70-72, 76, 80 and 85. Claims 70-92 are pending. Applicant's amendment has overcome the rejected under 35 U.S.C. 112, second paragraph.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant is claiming a CIP of application No. 08/784,829 (US 6,119,101) filed 1/17/1997, which claim provisional to 60/010087 filed 1/17/1996, and of 08/970,470 (US 6,286,002), filed 11/14/1997. However these applications do not include the claimed subject matter applicant is claiming in the instance application, therefore, cannot receive the benefit of the filing data of the parent cases (08/784,829) and 08/970,470 and also cannot receive the benefit of the provisional application (60/010,087). The parent cases do not disclose method and/or system of providing privacy through anonymity as disclosed in the instant application.

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/057,685 and 60/052,373) upon which priority is

Art Unit: 3622

claimed fails to provide adequate support under 35 U.S.C. 112 for claims 70-92 of this application. The provision applicants do not disclose method and/or system of providing privacy through anonymity as disclosed in the instant application. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/050,411) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 70-92 of this application. The provision applicants do not disclose "a payment key" in the manner used in the instant application.

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/047,341) upon which priority is claimed have been filed more than a year before the instant applicant was filed. Thus could not claim the benefit of the filing data of the provisional application.

Applicant is required to amend the specification in order to properly claim the benefit of earlier filing date.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

Art Unit: 3622

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 70-92 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gabber et al. U.S. Patent No. 5,961,593.

Regarding claims 70-72, 77, 78 and 80 Gabber teaches establishing a pseudo payment associated with financial information to facilitated purchase, wherein the pseudo payment includes pseudo credit account, pseudo expiration data; pseudo identity, providing the pseudo payment to seller and charging the real account of the user; establishing the pseudo identity at a privacy server; (see col. 8 lines 18-62, col. 10 lines 22-65, col. 11 line 54 to col. 13 line 53). Gabber teaches transmitting payment from the financial institution to the second user on behalf of the first user under the pseudo credit account identifier. Gabber teaches the proxy system provides substitute identifiers that include the feature of anonymity, keeping the identity of the user secret that is the server sites (second user) cannot determine the true identity of the first user (see col. 8 lines 35-44). Gabber also teaches the substitute identifiers transmitted to the server site (on behave of the first user) (see col. 10 lines 41-65). Gabber further teaches the central proxy system includes functionality necessary to support electronic payment, the users employ electronic payment information to engage in anonymous commerce with the server sites, further the substitute identifiers may be constructed at least in part using credit/debit card number. Since in Gabber the substitute identifiers are transmitted to the second user from the proxy system to engage in anonymous communication between the user and the server sites, it is clear that the

Art Unit: 3622

substitute identification created using the credit information is also sent to the second user from the proxy system on behalf of the first user during commerce transaction (see col. 12 lines 45-56).

Regarding claims 73-75 Gabber teaches establishing pseudo identity at proxy different from the central proxy when the user might not trust the central proxy (see col. 13 lines 27-53).

Claims 87, 88, 90 and 91 are rejected as stated above in claims 70-72, 77 and 78.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 76, 79, 89 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber further in view Official Notice.

Regarding claims 76, 79, 89 and 92, Gabber does not explicitly teach single use of credit account and identifying two actual payment type and establishing at a rule set defining when to use the each of the payment type. Official notice is taken that is well known in the art of e-commerce to set rules to define the use of accounts. Financial institutions allow account for single transaction or limited transaction or for specific use or transaction. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to include such rules in order to minimize fraud or misuse of credit cards.

Claims 81-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber further in view Boies et al. (US 6,006,200).

Regarding claim 81-86, Boies teaches arranging an entity for delivering a product to recipient for the seller and withholding from the seller information that would permit the seller to determine the actual identity of the buyer; generating a code; transferring the item based on the code... (see fig 2A-2C and col. 2 line 1 to col. 3 line 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Gabber's anonymous purchase with Boies's anonymous shipment system. One would be motivated to use Boies's shipping system for the purpose of providing a complete anonymity by protecting the identity of the buyer from the seller, as taught by Boies.

Response to Arguments

Applicant's arguments filed October 13, 2005, have been fully considered but they are not persuasive.

Applicant argues that Gabber does not teach transmitting the payment on behalf of the first entity from the financial institution to the second entity under the pseudo credit account identifier. Examiner disagrees. Gabber teaches the proxy system transmitting the substitute identification created using user's credit/debit card number, as indicated above.

Applicant traverses the rejection under 103 as being unpatentable over Gabber in view of official notice taken by the Examiner. If Applicant is challenging the examiner's taking of Official Notice, applicant does not provide adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The examiner's taking of Official Notice is maintained.

Art Unit: 3622

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

Yehdega Retta
RETTA YEHDEGA
PRIMARY EXAMINER